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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,354	07/20/2001	Kevin A. Jarrell	2003320-0032	2372
24280 7590 07/25/2007 CHOATE, HALL & STEWART LLP TWO INTERNATIONAL PLACE BOSTON, MA 02110			EXAMINER VOGEL, NANCY S	
			ART UNIT: 1636	PAPER NUMBER
			MAIL DATE 07/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/910,354	Applicant(s) JARRELL ET AL.	
	Examiner Nancy T. Vogel	Art Unit 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 12-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/18/07, 4/26/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/18/07 has been entered.

Claims 1-5, 12-21 are pending in the application.

Receipt of Information disclosure Statements on 7/18/07 and 4/26/07 is acknowledged.

Specification

The amendment filed 11/23/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Changes have been made at pages 34 and 35 which constitute new matter, which do not appear to be typographical errors, but rather, are substantial in nature. These alterations constitute new matter.

This objection is withdrawn regarding alterations to parts a)-d) (as referred to by applicants in their response).

This objection is maintained for the alterations listed in part e) in applicant's response. While it is agreed that "ribonucleotides" is not a recognized term, it cannot be determined that "ribonucleotides" was intended or supported. Furthermore, regarding altering "3-O-methyl" to "2'-O-methyl", applicant argues that one would know that 2'-O methyl was intended since 3'-O-methyl cannot occur at internal positions. However, it is not clear that only internal positions are intended in this section. Therefore, this objection is maintained.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102.

Claims 1, 2, 4, 5, 12, 14-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Harney et al. (US Patent US Patent 6,495,318) (previously cited).

This rejection is maintained essentially for the reasons made of record in the previous Office action, mailed 1/17/07. Applicant's arguments filed 6/18/07 have been considered, but have not been found convincing.

Applicants have argued that one cannot interpret the term "vector selection element" as including a restriction recognition site, since the claim has been amended to recite that the vector selection element comprises a selectable marker. However, it is maintained that a restriction recognition constitutes a selectable marker, since one could select for or against its presence. Therefore, the rejection is maintained.

Claim Rejections - 35 USC § 103

Claims 1-5, 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harney in view of Jarell (US Patent 5,498,531, "Jarrell '531") or Jarrell (US Patent 5,780,272 "Jarrell '272").

This rejection is maintained essentially for the reasons made of record in the previous Office action, mailed 1/17/07. Applicant's arguments filed 6/18/07 have been considered, but have not been found convincing.

Applicants have argued that since Harney do not disclose the subject matter of claim 1, the additional citation of Jarell '531 and Jarrell '272 does not render the claimed invention obvious, and that furthermore, Harney does not disclose the entire invention. However, as is set forth above, it is maintained that Harney do disclose the recited invention, since a restriction enzyme site may be considered to be encompassed by the recitation of "vector detection elements", and therefore, the rejection is maintained. Applicants have further argued that just because the references can be combined, does not render the invention obvious unless there is a suggestion in the art to do so. However, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, the Jarell references clearly disclose nucleic

Art Unit: 1636

acids that have added intronic elements to at least two of the nucleic acids, such that trans-splicing can take place between them in order to efficiently manipulate nucleic acids by specific cleavage and ligation (see column 2, line 33- column 3, line 40 of Jarrell '531, and col. 2, line 39 – col. 3, line 45 of Jerrell '272). The teaching is generally applicable to any method of manipulating nucleic acids, and therefore one would have been motivated to modify the primary reference using the teachings of Jerrell '531 and '272 in order to obtain the disclosed benefits of ease of manipulation of said nucleic acids, including joining said nucleic acids and eliminating non-essential regions. Therefore, the rejection is maintained.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy T. Vogel whose telephone number is (571) 272-0780. The examiner can normally be reached on 7:00 - 3:30, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1636

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NV
7/23/07


NANCY VOGEL
PRIMARY EXAMINER